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Paper No. 11

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SEP 10 2004

**OFFICE OF PETITIONS
ON PETITION**

In re Application of :
Grant et al. :
Application No. 09/922,658 :
Filed: August 6, 2001 :
Attorney Docket No. ORT 1483 :

This is a decision on the petition under 37 CFR 1.137(a), filed August 17, 2004, to revive the above-identified application.

The petition is **DISMISSED**.

Any request for reconsideration must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. Any reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(a)." This is **not** a final agency action within the meaning of 5 U.S.C. § 704.

Facts:

A restriction Notice requiring and election by applicant was mailed on November 12, 2002, which set an extendable one month period of time to respond.

A response, if received, was never entered into the file, and the application was considered abandoned as of December 13, 2002.

On June 16, 2003, a copy of the prior election allegedly filed on January 10, 2003, was sent by facsimile transmission to the examiner.

A telephone interview summary sheet completed by the examiner on June 16, 2003, states, "Advised the attorney that the return card was not stamped by the Patent Office and that a Petition to revive should be filed." The interview sheet indicates the examiner spoke with attorney Myra H. McCormack.

A Notice of Abandonment and a copy of the interview summary sheet were sent to petitioner at the address of record on June 17, 2003.

The petition states the Notice of Abandonment, and presumably the interview summary sheet, were not received.

Law:

A grantable petition under 37 CFR 1.137(a) must be accompanied by a copy of the required reply, the petition fee, and a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable.

Analysis:**The reply:**

A copy of the reply was not filed with the petition. However, a copy of the reply was filed on June 17, 2003. Although the June 17, 2003 reply *may* be legally sufficient, the reply does contain a small ambiguity. The reply states that petitioner elects claims 1-22, 44, and 45. However, handwritten on another sheet is the notation, "Elected 1-28 & 44-45." Petitioner should submit a new response clearly electing claims to prosecute.

The fee:

The fee for a petition under 37 CFR 1.137(a) is \$110. As will be discussed later, Office records indicate authorization to charge \$110 to petitioner's deposit account for a one month extension of time on January 21, 2003. Since the record fails to include any written authorization to charge the fee, the fee will be considered refundable and the Office will use the \$110 for the petition fee. It should be noted that, if a request for reconsideration under 37 CFR 1.137(a) is granted, petitioner will *not* need to submit \$110 for an extension of time since the application will be considered abandoned as of December 13, 2002, although revived subsequently.

The showing of unavoidable delay:

Two main issues exist.

The first issue:

The first issue concerns the adequacy of the evidence concerning the original submission of the response to the restriction requirement.

As stated previously, Office financial records do indicate \$110 was charged to petitioner's deposit account for a one month extension of time on January 21, 2003.

Petitioner has submitted a copy of the papers allegedly filed on January 21, 2003. The papers bear a certificate of mailing date of January 10, 2003. The certificate of mailing is signed by attorney Myra H. McCormack.

37 CFR 1.8(b) provides that when correspondence satisfies 37 CFR 1.8(a), but was not received by the Patent and Trademark Office, the correspondence will be considered timely if:

- (1) petitioner informs the Office of the previous mailing or transmission of the correspondence promptly after becoming aware that the Office has no evidence of receipt of the correspondence.
- (2) petitioner supplies an additional copy of the previously mailed or transmitted correspondence and certificate,
- (3) the petitioner includes a statement which attests on a personal knowledge basis, or to the satisfaction of the Commissioner, to the previously timely mailing or transmission. If the correspondence was sent by facsimile transmission, a copy of the sending unit's report confirming transmission may be used to support this statement, and
- (4) the Office may require additional evidence to determine if the correspondence was timely filed.

As to (3), the petition is signed by Hesna Pfeiffer, not Ms. McCormack. A statement by Myra H. McCormack, the individual with personal knowledge, should be submitted verifying that she did in fact mail the reply after she completed the Certificate of Mailing.

The second issue:

The record fails to establish the petition was timely filed. An applicant may not delay the filing of a petition once applicant discovers a problem exists.

37 CFR 1.137(a) requires the entire delay from the date of abandonment until the filing of a grantable petition to be unavoidable.

37 CFR 1.181(f) states in part, "Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely."

The record indicates that petitioner, via attorney McCormack, was aware of the existence of a problem with the receipt of the reply as early as June 16, 2003. The examiner's interview summary sheet states the examiner informed the attorney "that a Petition to revive should be filed." A petition was not filed until approximately 14 months later.

In addition to oral notification, the Office mailed a Notice of Abandonment on June 17, 2003. Petitioner alleges the Notice of Abandonment was never received.

In the absence of any irregularity in the mailing of the Office action, there is a strong presumption that the Office action, such as the Notice of Abandonment, was properly mailed and received. In order to overcome this presumption, a petition alleging non-receipt of an Office action must:

- (1) include a statement from practitioner stating that the Office action was not received,
- (2) attest that a search of the file jacket has been made,
- (3) attest that a search of all relevant docket records has been made,
- (4) include a copy of the docket record where the Office action would have been entered had it been received, and
- (5) include any additional information which may be required by the Commissioner.

The instant petition fails to address items (2), (3), and (4) above.

Conclusion:

The instant record fails to establish that relief under 37 CFR 1.137(a) is proper. Therefore, the petition must be dismissed.

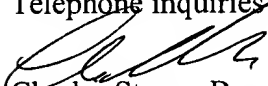
Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

By facsimile: (703) 872-9306
Attn: Office of Petitions

If a request for reconsideration is filed, and a decision on the new petition is not received within three months, petitioner may wish to call the number below to check on the status of the renewed petition.

Telephone inquiries should be directed to Petitions Attorney Steven Brantley at (703) 306-5683.


Charles Steven Brantley
Petitions Attorney
Office of Petitions